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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/806,919

03/23/2004

Roger Leyden

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3889

32116

7590

06/14/2006

WOOD, PHILLIPS, KATZ, CLARK & MORTIMER
500 W. MADISON STREET
SUITE 3800
CHICAGO, IL 60661

EXAMINER

SMITH, RICHARD A

ART UNIT

PAPER NUMBER

2859

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/806,919

Applicant(s)

LEYDEN ET AL.

Examiner

R. Alexander Smith

Art Unit

2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20, 22 and 29-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20, 22 and 29-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claims 29-32 are objected to because of the following informalities: Each of these claims start with "The method of forming an apparatus for gauging a dimension of an object according to claim 1"; however, claim 1 is drawn to an apparatus and not a method of forming an apparatus. Correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was

made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-3, 15-19 and 29-31 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over US 669,014 to Elborne in view of the website busy-kids.com/childfurniture/MIRRORS.html [hereinafter Busy-Kids].

Elborne discloses an apparatus for gauging dimensions comprising:

a) a wall having a generally flat front surface facing in a first direction and a peripheral edge, spaced graduations on the wall (e, f, g, h) relative to which a dimension of an object placed in front of the wall can be gauged, a surface on the wall which reflects an image (z) of an object (k) located in front of the wall, and at least one of i) a depiction of at least one of a) an animate object b) an inanimate object and c) a scene ii) at least one word iii) a design, and iv) a logo on the wall, in addition to the graduations (lines 79-83), and viewable from in front of the wall in conjunction with the spaced graduations and a reflective image from the surface on the wall;

b) wherein the wall has a length extending in a vertical direction and a width and the graduations allow gauging of the height of an object located in front of the wall;

c) wherein the length of the wall is substantially greater than the width of the wall;

d) wherein the apparatus has a front and rear with a thickness between the front and rear of the apparatus and an areal extent (wherever the advertisements are located on the mirror) and the apparatus has a substantially uniform thickness over substantially the entire areal extent of the apparatus (since the entire apparatus shows a consistent thickness in figure 2 over its entire

length then the areal extent limitation is inherently met since it is a portion of the entire apparatus);

e) the wall having a height and a width and first and second sides in a widthwise direction;

f) the wall being rectangular and having four transverse edge portions.

a) a wall having a generally flat front surface facing in a first direction and a peripheral edge, spaced graduations on the wall (e, f, g, h) relative to which a dimension of an object placed in front of the wall can be gauged, a surface on the wall which reflects an image (z) of an object (k) located in front of the wall, and at least one of i) a depiction of at least one of a) an animate object b) an inanimate object and c) a scene ii) at least one word iii) a design, and iv) a logo on the wall (lines 79-83), and viewable from in front of the wall in conjunction with the spaced graduations and a reflective image from the surface on the wall, the wall comprising a first layer having a front and rear,

b) the wall comprising a first layer defining a flat front surface, and

c) the method steps of providing a wall comprising a first layer with a front and a rear, providing at least one of i) a depiction... ..on the wall, and providing graduations on the first layer.

Elborne does not disclose

wherein the front surface has a first area and the at least one of i) a depiction of at least one of a) an animate object b) an inanimate object and c) a scene ii) at least one word iii) a

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design and iv) a logo occupies only a part of the first area and a user can see his reflected image in a portion of the first area not occupied by the at least one of i) a depiction... ...and iv) a logo in a manner that the reflected image appears to the user to be integrated with the subject matter of the at least one of i) a depiction... ...and iv) a logo;

wherein a portion of the peripheral edge is non-straight;

wherein a first spaced side has a non-straight configuration over more than one-half the height of the wall at the first spaced side;

wherein the wall has a nominally squared shape and one of the transverse edge portion has a first length and a running length substantially greater than the first length;

wherein the at least portion of the peripheral edge has adjacent contiguous portions which extend generally along first and second transverse lines, said lines defining an acute angle;

and the method steps of:

the wall is formed so that the shape of at least a portion of the peripheral edge is at least nominally matched in shape to a shape of at least a portion of the at least one of i) a depiction... ... and iv) a logo;

the graduations are located at the portion of the first area not occupied by the at least one of i) a depiction... ...and iv) a logo;

wherein the at least one of i) a depiction... ... and iv) a logo comprises an animal so that the user has a perception from the front of the apparatus that he/she is standing next to the animal.

Busy-Kids discloses a variety of mirrors for kids including a Concave Bubble Mirror (page 3), a Friendly T-Rex Mirror (page 3), a Bear Wall Mirror (page 4), and a Measure Me Mirror (page 6). Of these the Friendly T-Rex Mirror and Bear Wall Mirror have front surface having a first area and the at least one of i) a depiction... .. and iv) a logo occupies only a part of the first area (for the T-Rex along its back and tail and at its head, and for the Bear Wall at its head) and a user can see his reflected image in a portion of the first area not occupied by the at least one of i) a depiction... ..and iv) a logo (for the Friendly T-Rex at its belly and for the Bear Wall all parts except for the head) in a manner that the reflected image appears to the user to be integrated with the subject matter of the at least one of i) a depiction... ..and iv) a logo (for the Friendly T-Rex the image would be next to the Friendly T-Rex or possibly his lunch, that's assuming that he is not that friendly, and for the Bear Wall the image would be appear to be sitting in front and next to the Bear); wherein a portion of the peripheral edge is non-straight; wherein a first spaced side has a non-straight configuration over more than one-half the height of the wall at the first spaced side; wherein the wall has a nominally squared shape and one of the transverse edge portion has a first length and a running length substantially greater than the first length; wherein the at least portion of the peripheral edge has adjacent contiguous portions which extend generally along first and second transverse lines, said lines defining an acute angle (for the T-Rex at the neck to chin and for the Bear Wall at the waist between the legs and arms) and the methods of the wall is formed so that the shape of at least a portion of the peripheral edge is at least nominally matched in shape to a shape of at least a portion of the at least one of i) a depiction... .. and iv) a logo; and wherein the at least one of i) a depiction... .. and iv) a logo

comprises an animal so that the user has a perception from the front of the apparatus that he/she is standing next to the animal.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus, taught by Elborne, to include a front surface having a first area and the at least one of i) a depiction of at least one of a) an animate object b) an inanimate object and c) a scene ii) at least one word iii) a design and iv) a logo occupies only a part of the first area and a user can see his reflected image in a portion of the first area not occupied by the at least one of i) a depiction... ..and iv) a logo in a manner that the reflected image appears to the user to be integrated with the subject matter of the at least one of i) a depiction... ..and iv) a logo, as suggested by Elborne and taught by Busy-Kids, to include a peripheral edge shaped to match the depiction therein, to have the non-straight edge and this edge being over more than half the height, to have the running length greater than first length, and to have the acute angle, as taught by Busy-Kids, in order to make the height gauging apparatus more appealing to children and adults and to promote its distinctiveness and marketability, as suggested by Busy-Kids, to a user or purchaser.

With respect to the wall having a nominally squared shape: Elborne discloses a narrow rectangular apparatus designed as a profile or portrait type device wherein indicia in the form of instructions and ads may be added and wherein framing may be added. Busy-Kids discloses a variety of mirrors including octagon mirrors, circle mirrors, square mirrors and rectangular mirrors. Therefore, the wall being a nominally squared shape is only considered to be an obvious modification of a wall because the courts have held that a change in shape or

configuration, without any criticality, is within the level of skill in the art as the particular shape claimed by Applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide. In re Dailey, 149 USPQ 47 (CCPA 1976). In this case to provide a profile or portrait type view or in order to mount the device in a location where a full length version cannot be accommodated.

With respect to the method of the graduations are located at the portion of the first area not occupied by the at least one of i) a depiction... ..and iv) a logo: Elborne as modified by Busy-Kids discloses the claimed invention except for the graduations being located at the first area portion not occupied. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to place the graduations at a portion which is not occupied, since it has been held that rearranging parts of an invention involves only routine skill in the art, In re Japikse 86 USPQ 70, and since it would allow the user to more easily distinguish his height and the graduations in the mirror from the at least one i) depictions... ..and iv) logos.

4. Claim 14 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Elborne and Dachille as applied to claims 1-3, 15-19 and 29-31 above, and further in view of US 4,851,061 to Sorkoram.

Elborne and Dachille together teach all that is claimed as discussed in the above rejections of claims 1-3, 15-19 and 29-31 except for the portion of the peripheral edge being formed through laser cutting.

Sorkoram '061 discloses a method and apparatus wherein mirrors (column 1, lines 35-43) can be formed from thermoplastic materials and lasers can be used to cut said thermoplastic materials and leave edges that solidify to present a precise polished surface quickly versus rough unpolished edges and a time consuming process (column 1, lines 55-57 versus lines 15-28). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to make the apparatus for gauging, taught by Elborne, of thermoplastics and to form the edge via laser cutting, as taught by Sorkoram '061, in order to provide a quick computer controlled laser cut and to obtain precise polished edges.

5. Claim 20 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Elborne and Dachille as applied to claims 1-3, 15-19 and 29-31 above, and further in view of US 2,369,988 to Steckler.

Elborne and Dachille together teach all that is claimed as discussed in the above rejections of claims 1-3, 15-19 and 29-31. Furthermore, Busy-Kids appears to show mounting locations within the body of the mirror although it is not clearly seeable from the pictures. See the Bear Wall mirror and the mounts located at the heels of the feet and at the ends of the arms and ears. Elborne does not disclose and Busy-Kids does not clearly disclose at least one opening through the wall capable of receiving a fastening to facilitate mounting.

Steckler discloses an apparatus for gauging a dimension wherein the apparatus includes an opening (14) through the wall to facilitate mounting. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus, taught by

Elborne, to include at least one opening, as suggested by Busy-Kids and taught by Steckler, in order to help the installer in mounting the apparatus to a wall.

6. Claim 32 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Elborne and Busy-Kids as applied to claims 1-3, 15-19 and 29-31 above, and further in view of US D24,404 to Wiederer.

Elborne and Dachille together teach all that is claimed as discussed in the above rejections of claims 1-3, 15-19 and 29-31 except for the at least one of i) a depiction... .. and iv) a logo frames/edges the portion of the first area.

Wiederer discloses a framed mirror wherein the design is in the form of clown supporting the mirror within a ring. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the design, taught by Elborne as modified by Busy-Kids, to include a clown in a squat position supporting a mirror, as suggested by Wiederer, in order to amuse and entertain the kids by allowing them to pretend that they are riding on the back of the clown in addition to taking their height measurements.

7. Claim 4-7 and 10-13 and 22 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Elborne and Dachille as applied to claims 1-3, 15-19 and 29-31 above, and further in view of US 5,128,194 to Sorko-Ram.

Elborne and Dachille together teach all that is claimed as discussed in the above rejections of claims 1-3, 15-19 and 29-31 except for

the at least one of i) a depiction... ..and iv) a logo is applied to the rear of the first layer and viewable through the first layer at the front,

the first layer comprises a clear plastic material,

the first layer having a thickness between the front and rear in the range of 0.04-0.12 inches,

the rear of the first layer being coated with a first material that is viewable through the first layer and reflects an image of an object located in front of the first layer,

the wall comprising a second layer applied to the rear of the first layer so that the first material and the at least one of i) a depiction... ..resides between the layers,

the second layer having a front and rear and a thickness in the range of 0.04-0.12 inches,

the second layer being of high impact polystyrene,

the second layer being secured to the first layer through a pressure sensitive adhesive,

a reflective coating being applied to the first layer over the at least of i) a depiction

to allow an image of an object located in front of the wall to be viewable through the first layer.

Sorko-Ram discloses a decorative mirror apparatus wherein a depiction (22) is applied to the rear of the first layer (12) and is viewable through the first layer, the first layer comprises a clear plastic material (column 1, lines 45-50) or glass (column 2, lines 3-6), the rear of the first layer being coated with a first material (28) that is viewable through the first layer and reflects an image of an object located in front of the first layer, the wall comprising a second layer (36)

applied to the rear of the first layer so that the first material and the at least one of i) a depiction...
...resides between the layers, the second layer being secured to the first layer through a suitable
adhesive (column 2, lines 66-68), the wall comprising a second layer (36) wherein the at least
one of i) a depiction... ..located between the first and second layers so as to be viewable from in
front of the wall through the first layer, and the method step of coating the rear through opaque
inks, silk screening, colored layering, etc. (column 1, lines 50-56). Furthermore, Sorko-Ram
discloses that the first layer can be applied through vapor deposition.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the
invention to modify the apparatus and method, taught by Elborne, to have the depiction and
reflective coating applied to the rear of the first layer and between the layers, to make the first
layer of clear plastic material, to apply a second layer to the rear of the first layer, to secured the
layers through an adhesive, as taught by Sorko-Ram, in order to sandwich the design and the
reflective coating for protection from the environment, to make the first layer less susceptible to
breakage, to lighten the weight of the apparatus, and to provide a backing for strengthening and
supporting the apparatus.

With respect to the the first layer having a thickness between the front and rear in the
range of 0.04-0.12 inches, and the second layer having a front and rear and a thickness in the
range of 0.04-0.12 inches: These limitations are only considered to be the "optimum" values of
the thicknesses of the first and second layers disclosed by Elborne as modified by Sorko-Ram, as
stated above, that a person having ordinary skill in the art would have been able to determine
using routine experimentation based, among other things, on provided enough thickness to

provide the necessary strength, resistance to breakage, and support for the apparatus while keeping the weight and the costs down. See In re Boesch, 205 USPQ 215 (CCPA 1980).

With respect to the second layer being of high impact polystyrene and the adhesive being a pressure sensitive adhesive: These materials are only considered to be the use of "optimum" or "preferred" materials that a person having ordinary skill in the art at the time the invention was made using routine experimentation would have found obvious to provide to make the second layer and the adhesive disclosed by Elborne as modified by Sorko-Ram since they are well known types of materials used to make signs and for adhering components together and since it has been held to be a matter of obvious design choice and within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use of the invention. In re Leshen, 125 USPQ 416. In this case to provide a support that is weather resistant, lightweight, and break resistant and to provide an adhesive suitable to join the layers together.

8. Claim 8 and 9 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Elborne, Dachille and Sorko-Ram as applied to claims 4-7 and 10-13 and 22 above, and further in view of US 5,702,649 to Taylor.

Elborne, Dachille and Sorko-Ram together teach all that is claimed as discussed in the above rejections of claims 4-7, 10-13 and 22 except for the first material being aluminum and the metal material being applied in a vacuum chamber.

Taylor discloses that metal material such as aluminum can be vapor deposited onto plastic surfaces to form a thin reflective layer when the metal material is placed on a heating coil in a vacuum chamber (abstract and column 4, lines 22-31). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to augment the apparatus, taught by Elborne and Sorko-Ram, to include a metal, aluminum, applied in a vacuum chamber, as taught by Taylor, in order to apply a cheap commonly used material for the reflective surface and to provide means for applying a thin uniform coating.

9. Claim 8 and 9 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Elborne, Dachille and Sorko-Ram as applied to claims 4-7, 10-13 and 22 above, and further in view of US 2,145,732 to Nickle.

Elborne, Dachille and Sorko-Ram together teach all that is claimed as discussed in the above rejections of claims 4-7, 10-13 and 22 except for the first material being aluminum and the metal material being applied in a vacuum chamber.

Nickle discloses that metal material such as aluminum can be vapor deposited onto surfaces to form a thin reflective layer when the metal material is placed on a heating coil in a vacuum chamber (lines 12-16). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to augment the apparatus, taught by Elborne and Sorko-Ram, to include a metal, aluminum, applied in a vacuum chamber, as taught by Nickle, in order to apply a cheap commonly used material for the reflective surface and to provide means for applying a thin uniform coating.

Response to Arguments

10. Applicant's arguments filed March 29, 2006 with respect to Elborne in view of Dachille have been fully considered but are moot in view of the new secondary reference applied for the new ground(s) of rejection to address the new claim limitations.

With respect to Sorkoram '061 teaching of a single layer of thermoplastic versus the Applicant's composite structure: Sorkoram mainly discusses a process for cutting thermoplastic sheets with accuracy and without distortion of the sheets. Sorkoram discloses that the laser is of a temperature that vaporizes the thermoplastic along with the layer of reflective material thereon and discloses steps taken to make sure that the thermoplastic is properly cooled and that the gases are vented to prevent distortion. Sorkoram does not address the thickness of the sheets, or if these sheets are one piece, layered or laminated, etc., only that the sheets are thermoplastic. It therefore appears to the examiner that the process taught by Sorkoram can reasonably cut a composite as long as the material is basically thermoplastic and of the proper thickness. For an analogy, just as a 10" table saw can saw a 3/4" sheet of plywood or a 3/4" piece of oak.

The applicant's other comments and remarks are noted.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

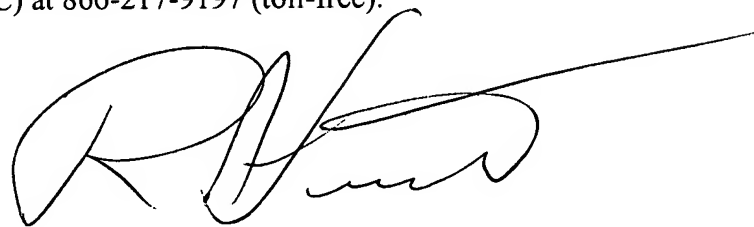
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The prior art cited in PTO-892 and not mentioned above disclose related apparatus and methods.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. Alexander Smith whose telephone number is 571-272-2251. The examiner can normally be reached on Monday through Friday from 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F. Gutierrez can be reached on 571-272-2245. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'R. Alexander Smith', with a long horizontal flourish extending to the right.

R. Alexander Smith
Primary Examiner
Technology Center 2800

RAS
June 9, 2006